UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
2491	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/531,430	JEAL ET AL.
	Examiner	Art Unit	
	MATTHEW T. HENNING	2491	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>10 September 2010</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-53</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-53</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on <u>15 April 2005</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☒ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1   This action is in response to the communication filed on 9/10/2010.

2   **DETAILED ACTION**

3   Applicant's arguments with respect to claim 1-53 have been considered but are moot in

4   view of the new ground(s) of rejection.

5   The examiner notes that the applicants' attempt to rely upon a declaration under 37 CFR

6   1.132 is not persuasive. The declaration is made by one of the two inventors, who has a vested

7   interest in the application, and as such has been given very little weight. Again, however, this is

8   a moot point, in view of the new grounds of rejection presented below.

9   All objections and rejections not set forth below have been withdrawn.

10   Claims 1-53 have been examined.

11
12   ***Claim Rejections - 35 USC § 103***

13   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

14   obviousness rejections set forth in this Office action:

15   *A patent may not be obtained though the invention is not identically disclosed or*
16   *described as set forth in section 102 of this title, if the differences between the subject matter*
17   *sought to be patented and the prior art are such that the subject matter as a whole would have*
18   *been obvious at the time the invention was made to a person having ordinary skill in the art to*
19   *which said subject matter pertains. Patentability shall not be negatived by the manner in which*
20   *the invention was made.*
21
22   Claims 1-3, 5, 14-17, 18-23, 25, 34-43, 46-51, and 53 are rejected under 35 U.S.C. 103(a)

23   as being unpatentable over Ohashi et al. (US Patent Number 5,761,309) hereinafter referred to as

24   Ohashi, and further in view of Vatanen (US Patent Number 6,169,890).

25
26   Regarding claims 1, 21, and 42, while Ohashi disclosed a device (card reader 11) for

27   connection to a data processing apparatus (client terminal 12), the device (card reader 11)

1   including authentication storage means (smart card 10) operatively coupled thereto for storing

2   predetermined authentication information respective to a user (Ohashi Col. 12 Lines 1-29), the

3   authentication storage means (smart card 10) being registered with a telecommunications system

4   (authentication center) which includes authenticating means (AuC data) and for which the user

5   has a telecommunications terminal (other client terminal; Col. 11 Lines 30-33), the device (card

6   reader 11), when operatively coupled to the authentication storage means (smart card 10), being

7   responsive to an input message for deriving a response dependent on the input message and on

8   the authentication information for enabling the authenticating means (AuC data) to carry out an

9   authentication process via a communication link (network 13) with the authenticating means

10   (AuC data) in the said telecommunications system (authentication center) whereby to

11   authenticate a subsequent transaction by the user with the data processing apparatus (client

12   terminal 12) (Ohashi Col. 12 Lines 1-29), and which involves use of the data card by the

13   authentication storage means (smart card 10) (Ohashi Col. 12 Lines 1-29), and wherein the

14   device controls access to the authentication information (Ohashi Fig. 6 wherein all

15   communications in and out of the smartcard pass through the reader/writer), but Ohashi did not

16   specifically state that the predetermined authentication information stored by the authentication

17   storage means (smart card 10) corresponds to information which is used to authenticate the user

18   registered with the telecommunications system (authentication center) in relation to use of that

19   users telecommunications terminal in the telecommunications system (authentication center)

20   (Ohashi Col. 12 Lines 1-29), but the authentication process for authenticating the transaction by

21   that user with the data processing apparatus not requiring use of the user's telecommunications

22   terminal (Ohashi Col. 12 Lines 1-29) nor requiring the telecommunications terminal to be

1   actually authenticated by that information in relation to the telecommunications system (Ohashi

2   Col 12 lines 1-29).

3   Vatanen teaches an analogous system in which a user telephone's SIM card of a GSM

4   telecommunications network is used to provide authentication of a user for service transactions.

5   Vatanen teaches that the SIM card is placed in a card reader at the point of sale, the user enters a

6   PIN which is verified with data stored in the SIM card, at which point the point of sale system is

7   used to authenticate the SIM card to the GSM system, thereby providing authentication of the

8   user of the SIM card via the GSM telecommunications system, and the system further utilizing a

9   user's local authentication to the GSM-network all the way to the service provider. (Vatanen

10   Summary of the Invention and Col. 4 Line 64 – Col. 5 Line 20). Vatanen teaches that the use of

11   the local authentication of the GSM system provides high data security along with the user

12   authentication (Vatanen Summary of the Invention).

13   It would have been obvious to the ordinary person skilled in the art at the time of

14   invention to have employed the teachings of Vatanen in the system of Ohashi by utilizing a

15   user's telephone GSM SIM card to provide the authentication of the user via the GSM system,

16   and to provide a various number of services, such as financial transactions, in the system of

17   Ohashi, as taught by Vatanen. This would have been obvious because the ordinary person

18   skilled in the art at the time of invention would have been motivated to provide additional

19   services to the users, and to also provide high data security along with the user authentication of

20   the system, utilizing a strong user authentication system which was already widespread.

21   Regarding claims 2 and 22, Ohashi and Vatanen taught security data entry means for

22   obtaining security data independently of the data processing apparatus, and means for analyzing

1   the entered security data for determining whether to allow access to the predetermined

2   information (Ohashi Col. 12 Lines 1-29 and Vatanen Summary of the Invention and Col. 4 Line

3   64 – Col. 5 Line 20).

4   Regarding claims 3, and 23, Ohashi and Vatanen taught wherein the data entry means

5   comprises alphanumeric data entry means (Ohashi Col. 12 Lines 1-29).

6   Regarding claims 5, 25, and 43, Ohashi and Vatanen taught that the security data

7   comprises a Personal Identification Number (PIN) and the analyzing means compares the PIN

8   obtained by the security data entry means with a PIN stored on the authentication storage means

9   and only allows access to the predetermined information when the respective PINs match

10   (Ohashi Col. 12 Lines 1-29 and Vatanen Summary of the Invention and Col. 4 Line 64 – Col. 5

11   Line 20).

12   Regarding claims 14 and 34, Ohashi and Vatanen taught that each user is authenticated in

13   the telecommunications system by use of a subscriber identity module, and in which the

14   authentication storage means respective to that user corresponds to or simulates the subscriber

15   identity module for that user (Vatanen Summary of the Invention and Col. 4 Line 64 – Col. 5

16   Line 20).

17   Regarding claims 15, and 35, Ohashi and Vatanen taught that the transaction is a

18   transaction involving use of data processing functions of the data processing apparatus (Ohashi

19   Col. 12 Lines 30-36 and Vatanen Summary of the Invention and Col. 4 Line 64 – Col. 5 Line

20   20).

1   Regarding claims 16, and 36, Ohashi and Vatanen taught that the authentication storage

2   means is specific to that device (Ohashi Col. 11 Lines 65-67 and Vatanen Summary of the

3   Invention and Col. 4 Line 64 – Col. 5 Line 20).

4   Regarding claims 17, and 38, Ohashi and Vatanen taught that the authentication process

5   involves the sending of a message and the generation of a response dependent on the message

6   and the predetermined information (Ohashi Col. 12 Line 55 – Col. 13 Line 10 and Vatanen

7   Summary of the Invention and Col. 4 Line 64 – Col. 5 Line 20).

8   Regarding claims 18, 39 and 40, Ohashi and Vatanen taught that the telecommunications

9   system includes means for levying a charge for the transaction when authorized (Vatanen

10   Summary of the Invention and Col. 4 Line 64 – Col. 5 Line 20).

11   Regarding claims 19 and 20, see Ohashi Fig. 1, and Vatanen Fig. 2.

12   Regarding claim 37, Ohashi and Vatanen taught that the authentication storage means is

13   associated with the data processing apparatus by being associated with data or software for use

14   by that data processing apparatus (Ohashi Col. 12 Lines 1-29 and Vatanen Summary of the

15   Invention and Col. 4 Line 64 – Col. 5 Line 20).

16   Regarding claim 41, Ohashi taught that the data processing apparatus is a personal

17   computer (Ohashi Col. 5 Paragraph 2 and Vatanen Summary of the Invention and Col. 4 Line 64

18   – Col. 5 Line 20).

19   Regarding claims 46, 49, and 53, while Ohashi and Vatanen disclosed the smart card

20   communicating with a smart card reader, Ohashi failed to disclose the communication being

21   wireless. However, it was well known at the time of invention for smart cards to communicate

22   wirelessly. As such, it would have been obvious to the ordinary person skilled in the art at the

1   time of invention to have provided the communications wirelessly. This would have been

2   obvious because the ordinary person skilled in the art would have been motivated to increase the

3   ease of use for the user.

4   Regarding claims 47, 48, 50, and 51, Ohashi and Vatanen taught that that the SIM

5   authenticates the transaction when the SIM is operable in a mobile terminal (Vatanen Summary

6   of the Invention and Col. 4 Line 64 – Col. 5 Line 20 and Fig. 2).

7

8   Claims 4, 6-13, 24, 26-33, 44-45, and 52 are rejected under 35 U.S.C. 103(a) as being

9   unpatentable over Ohashi and Vatanen as applied to claims 1, 21, and 42 above, and further in

10   view of Caputo et al. (US Patent Number 5,778,071) hereinafter referred to as Caputo.

11   Regarding claims 4, 6, 24 and 26, while Ohashi and Vatanen disclosed a smart card

12   reader, and entry of PIN numbers, Ohashi failed to disclose the smart card reader having a

13   keypad or a display.

14   Caputo teaches, in Fig. 1E and Col. 7 Lines 37-61, a smart card reader which has a

15   keypad and a display far facilitating the entry of PIN numbers.

16   It would have been obvious to the ordinary person skilled in the art at the time of

17   invention to have employed the teachings of Caputo in the smart card system of Ohashi and

18   Vatanen by utilizing the smart card reader of Caputo. This would have been obvious because the

19   ordinary person skilled in the art at the time of invention would have been motivated to provide a

20   specific means for the entry of PIN numbers, as generically suggested by Ohashi.

1   Regarding claims 7 and 27, Ohashi, Vatanen and Caputo taught a data processing module

2   for controlling the communication with the data processing apparatus (See Caputo Fig. 2

3   Element 172).

4   Regarding claims 8 and 28, Ohashi, Vatanen and Caputo taught that the data processing

5   module of the device is configured for communicating with a corresponding data processing

6   module of the data processing apparatus (Caputo Fig. 5A).

7   Regarding claims 9 and 29, Ohashi, Vatanen and Caputo taught that communication

8   between the authentication storage means and the data processing apparatus is performed via the

9   respective data processing modules (Caputo Fig. 2).

10   Regarding claims 10, 30 and 44, Ohashi, Vatanen and Caputo taught that the data

11   processing module of the device includes means for decrypting encrypted data received from the

12   data processing module of the data processing apparatus (Ohashi Col. 12 Lines 30-36 and

13   Caputo Fig. 6 and Col. 10 Line 51 - Col. 11 Line 59).

14   Regarding claims 11, 31, and 45, Ohashi, Vatanen and Caputo taught the data processing

15   module of the device includes means for encrypting data transmitted to the data processing

16   module of the data processing apparatus (Caputo Fig. 6 and Col. 10 Line 51 - Col. 11 Line 59).

17   Regarding claims 12, 32, and 52, Ohashi, Vatanen and Caputo taught that the respective

18   data processing modules comprise a key for allowing encryption and/or decryption of data

19   (Caputo Fig. 6).

20   Regarding claims 13, and 33, Ohashi, Vatanen and Caputo taught that the key comprises

21   a shared secret key for each of the respective data processing modules (Caputo Fig. 6 and Col. 10

22   Line 51 - Col. 11 Line 59).

1   *Conclusion*

2   Claims 1-53 have been rejected.

3   The prior art made of record and not relied upon is considered pertinent to applicant's

4   disclosure.

5   Any inquiry concerning this communication or earlier communications from the

6   examiner should be directed to MATTHEW T. HENNING whose telephone number is

7   (571)272-3790. The examiner can normally be reached on M-F 8-4.

8   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

9   supervisor, Ashok Patel can be reached on (571)272-3972. The fax phone number for the

10   organization where this application or proceeding is assigned is 571-273-8300.

11   Information regarding the status of an application may be obtained from the Patent

12   Application Information Retrieval (PAIR) system. Status information for published applications

13   may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

14   applications is available through Private PAIR only. For more information about the PAIR

15   system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

16   system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

17   like assistance from a USPTO Customer Service Representative or access to the automated

18   information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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20
21   /Matthew T Henning/
22   Primary Examiner, Art Unit 2491
23